

REMARKS

Claims 1-13 are pending in the above-identified application. Support for new claims 10-13 is found at pages 9, 10, 19 and 21 of the specification.

Obviousness-Type Double Patenting Issue

Claims 1-9 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of Fujiki '638 (USP 6,645,638) which shares a common assignee with the present application, i.e. Shin-Etsu Chemical Co., Ltd.

The above-noted double patenting rejection is respectfully traversed for the following reasons.

Reasons Supporting Withdrawal of Double Patenting Rejection

It is the position of the Patent Examiner that component (D) of the composition of Fujiki '638 overlaps with component (D) of the composition of the present application. However, the proper standard for determining whether "double patenting" exists requires that the granted patent include claims which suggest and make "obvious" the claims of the pending application. See *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998); and MPEP 804. In the present

situation, Fujiki '638 includes component (D) which defines two categories of compounds including [1] a first category of compounds which cannot have a siloxane structure, and [2] a second category of compounds which is defined as "esters of saturated polyfunctional carboxylic acids". Category [1] clearly excludes the definition of component (D) in the claims of the present invention. Category [2] does not suggest or make "obvious" the compounds of component (D) of the claims of the present application which require that the compound be an "organosilicon compound" and have a "siloxane skeleton".

In view of the above, it is submitted that it is clear from reading the claims of the present application and the claims of Fujiki '638 that an obviousness-type double patenting rejection fails to be supported, even taking into account the "One-Way Obviousness" test (note MPEP 804, rev. February, 2003, page 800-23). Consequently, it is requested that the above-noted rejection be withdrawn.

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should now be placed condition for allowance.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No.

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32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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